

REMARKS

Applicant has carefully reviewed the Office Action of May 7, 2003 and offers the following remarks.

Finley et al.

Claims 1, 4-9, 11-21, and 28-33 were rejected under 35 U.S.C. § 103 as being unpatentable over Finley et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the reference each and every claim element is taught or suggested. MPEP § 2143.03. If the Patent Office cannot show where a claim element is taught or where there is a suggestion to modify the reference to include a claim element, the claim is patentable over the reference.

Applicant initially objects to the lack of cohesion within the Office Action. Claims 1, 13, 14, and 20 are addressed initially at line 14 of page 2, extending to line 4 of page 3. Then, the claims are revisited briefly at page 4, lines 17-20. There is no ready explanation for why this analysis is divided and this division causes the Office Action's analysis to be disjointed.

Applicant specifically traverses the rejection on the grounds that the Patent Office has not established *prima facie* obviousness, and thus, the claims are patentable over the rejection. Specifically, the Patent Office has not shown where the elements discussed in the previous response are taught or suggested by the reference.

With respect to claims 1 and 14, after scouring the Office Action, Applicant located the notation at page 4, lines 17-20 wherein the Patent Office alleges that the IP address and the unique port address are located at column 6, lines 50-62. Applicant addressed this in the previous response. The Patent Office merely reiterates its prior statement and provides no analysis as to why this passage teaches the claim element. As previously explained, this passage does not, in fact, teach or suggest the claim element and thus, the Patent Office has failed to establish *prima facie* obviousness with respect to these claims and the claims which depend therefrom. Specifically, while the passage does indicate that the SM 300, DC 310 and remote connection 400 use TCP/IP, there is no teaching or suggestion that the display controller has its own IP address, nor is there any teaching or suggestion that the browser applications are assigned

ports associated with that IP address. Such a general teaching that TCP/IP is used does not equate to the specific recitation in the claim.

The Patent Office, in its "Response to Arguments" section, does state that "Applicant's claims, as currently written, and reasonably broadly construed, are open to the interpretation that it would be inherent that a unique TCP/IP address would be required to allow a 'kiosk' embodied, for example, in Finley by a fuel dispenser, to be connected to the internet." (Office Action, page 8). Applicant reminds the Patent Office of the standard for inherency. For something to be inherent, it must **necessarily** be present in the reference. MPEP § 2112. It is readily apparent to one of ordinary skill in the art that a unique IP address is not **necessarily** present for a given display controller. Even if it were obvious, as alleged by the Patent Office later in the paragraph, to have a unique IP address associated with the display controller, there is still no teaching or suggestion that each browser application has a unique port associated with the IP address. The Patent Office has over-generalized the teachings of the reference and has not constructed a proper rejection. In light of the failure of the Patent Office to provide a proper rejection, it is readily apparent that the claims define over the references of record and the claims are allowable.

With respect to claim 13, the Patent Office does not address the wireless limitation in its claim element analysis. However, in the "Response to Arguments" section, the Patent Office alleges that "it would, at the very least, be obvious for one ordinarily skilled in the art to provide a wireless connection to such a POTS line or to access a POTS line through the normal wireless cell phone network to access the particular phone address." Applicant respectfully traverses. The Patent Office is required to set forth particularized findings of fact about where there is a suggestion to modify a reference. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Patent Office has made no such findings, and thus, the Patent Office has not constructed a proper rejection. In light of the failure of the Patent Office to provide a proper rejection, it is readily apparent that claim 13 defines over the references of record and claim 13 is allowable.

With respect to claim 20, Applicant notes that the Patent Office provides no analysis as to where the reference teaches or suggests a command is sent to a printer. Unlike the other independent claims wherein the claim analysis section omitted discussion of an element, the Patent Office does not address this in the "Response to Arguments" section. To this extent, the Patent Office has not shown where the reference teaches or suggests a claim element for each of

the independent claims, and thus, the Patent Office has not established *prima facie* obviousness. In light of the failure of the Patent Office to provide a proper rejection, it is readily apparent that claim 20 defines over the references of record and claim 20 is allowable.

Siefert

Claims 1, 14, and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Siefert. Applicant respectfully traverses. For the Patent Office to issue a proper anticipation rejection, the Patent Office must show where the reference teaches each and every element of the claims. MPEP § 2131. The Patent Office has not shown where certain elements of the claim are shown by the reference. Specifically, for claims 1 and 14, there is no analysis as to where in the reference Siefert teaches that the display controller has an IP address and that the browser applications have unique port addresses. For claim 20, there is no analysis as to where in the reference Siefert teaches that a printer is used. The burden is on the Patent Office to show where the element is located in the reference. Applicant has scoured the reference and finds no such teaching or suggestion. To this extent, the reference does not show each and every claim element and the claims are not anticipated. Applicant requests withdrawal of the rejection based on Siefert at this time.

Double Patenting

To put the case in a better condition for appeal and without admitting the propriety of the rejection, Applicant herein submits a terminal disclaimer for U.S. Patents 6,052,629 and 6,176,421, thereby addressing the double patenting rejection.

Conclusion


The Patent Office has not met its burden in showing how the references anticipate or render obvious the claims at issue. Specifically, each of the independent claims has an element which the Patent Office has not shown, even under a broad reasonable interpretation. Applicant reminds the Patent Office that the statute says that "[a] person shall be entitled to a patent

unless" 35 U.S.C. § 102. Since the Patent Office has not established the proof required to meet the requirements of the "unless" clause of the statute, Applicant is entitled to this patent. Applicant requests claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:


Steven N. Terranova
Registration No. 43,185
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

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